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TO: Commissioner for Patents
Attn: Examiner William K. Cheung
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Alexandria, VA 22313-1450

FROM: William J. Wood
OUR REF.: G&C 130.30-US-U2
TELEPHONE: (310) 642-4144

Total pages, including cover letter: 6

PTO FAX NUMBER: (703) 872-9306

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Title of Document Transmitted:	RESPONSE TO RESTRICTION REQUIREMENT.
Applicants:	Glenn Noronha et al.
Serial No.:	10/075,415
Filed:	February 14, 2002
Group Art Unit:	1713
Title:	POLYMERS FUNCTIONALIZED WITH FLUORESCENT BORONATE MOTIFS AND METHODS FOR MAKING THEM
Our Ref. No.:	G&C 130.30-US-U2

Please charge all fees to Deposit Account No. 50-0494 of Gates & Cooper LLP.

By: W. J. Wood
Name: William J. Wood
Reg. No.: 42,236

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W. J. Wood
Signature

10/26/04
Date

WJW/sjm

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Confirmation No.: 7551
Due Date: October 30, 2004**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants:	Jonathan Reilly et al.	Examiner:	William K. Cheung
Serial No.:	10/075,415	Group Art Unit:	1713
Filed:	February 14, 2002	Docket:	G&C 130.30-US-U2
Title:	POLYMERS FUNCTIONALIZED WITH FLUORESCENT BORONATE MOTIFS AND METHODS FOR MAKING THEM		

CERTIFICATE OF MAILING OR TRANSMISSION UNDER 37 CFR 1.8I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) 872-9306 on October 26, 2004.Signature: Typed Name of Person Mailing this Certificate: Suzie McCleaveMAIL STOP AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

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- ☒ Transmittal sheet, in duplicate, containing a Certificate of Mailing or Transmission under 37 CFR 1.8.
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Please consider this a **PETITION FOR EXTENSION OF TIME** for a sufficient number of months to enter these papers, if appropriate.

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Customer Number 22462
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(310) 641-8797

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Typed Name of Person Mailing this Certificate: Susan McCleave

MAIL STOP AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

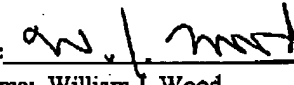
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Typed Name of Person Mailing this Certificate: Suzie McCleave

RESPONSE TO RESTRICTION REQUIREMENT

MAIL STOP AMENDMENT

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action dated September 30, 2004, please amend the above-identified application as follows:

REMARKS

The Office Action dated September 30, 2004 required restriction of the claims into 2 claim Groups. In response, Applicants elect Group I, namely claims 1-28. However, Applicants do so with traverse. Applicants dispute the assertion by the Office that the 2 claim Groups involve separate and distinct inventions.

35 U.S.C. §121 provides that "If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." M.P.E.P. §802.01 deviates from the plain meaning of "independent and distinct" by interpreting "and" to mean "or". The Patent Office relies on the absence from the legislative history of anything contrary to this interpretation as support for their position that "and" means "or". Applicants respectfully note that this position is contrary to the rules of statutory construction. Restriction between two dependent inventions is not permissible under the plain meaning of 35 U.S.C. §121. Applicants further urge the Examiner take into consideration that the subject matter of each of the claim Groups is linked by a common inventive concept.

According to M.P.E.P. §803, there are two criteria for a proper restriction requirement. First, the two inventions must be independent and distinct. In addition, there must be a serious burden on the Examiner if restriction is not required. Even if the first criterion has been met in the present case, which it has not, the second criterion has not been met.

Applicants assert that a search into prior art with regard to the invention of the different Groups is so related that separate significant search efforts should not be necessary. Accordingly, there is no serious burden on the Examiner to collectively examine the different claim Groups of the subject application. Therefore, restriction is not proper under M.P.E.P. §803.

Consequently, Applicants respectfully request the Examiner reconsider and withdraw the restriction requirement. It is also submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that

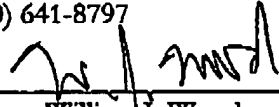
can be resolved in a telephone interview, the Examiner is urged to call Applicants' undersigned attorney.

Respectfully submitted,

GATES & COOPER LLP
Attorneys for Applicant(s)

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WJW/